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EXAMINER

KUCAB, JAMIE R

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3621

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/924,463	Applicant(s) LITKE ET AL.	
	Examiner JAMIE KUCAB	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on August 19, 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14, 15, 30, 31, 33-38, 40-45 and 47-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14, 15, 30, 31, 33-38, 40-45 and 47-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination ("RCE") under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 19, 2008 has been entered.

Acknowledgements

2. In accordance with the RCE above, claims 14, 15, 30, 31, 33-38, 40-45, and 47-50 are currently pending.
3. This Office action is given Paper No. 20081023 for reference purposes only.
4. Based on a comparison of the PGPub 2003/0033207 with Applicant's originally submitted specification, the PGPub appears to be a fair and accurate record of the Applicant's specification. Therefore, if necessary any references in this action to Applicant's specification refer to paragraph numbers in the PGPub.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 14, 15, 30, 31, 33-38, 40-45, and 47-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant's recitations in claims 14, 27, and 35 of a "first computer," "second computer," "third computer," and three or four instances of "at least one computer system" are unclear. It is not clear whether the claims recite limitations of only three computers/computer systems or whether there are as many as seven computers/computer systems. It appears that the claims would be less confusing if Applicant would replace each instance of "at least one computer system" with "the first computer," "the second computer," and "the third computer" where appropriate.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 14-17 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (U.S. Publication No. 2001/0020222 A1) in view of Rhodes (U.S. Patent No. 5,887,363) in view of Hersey (Reference U on the PTO-892 form mailed June 22, 2007) and further in view of Baker et al. (U.S. Patent No. 6,861,396).

9. As per claim 14, Lee clearly teaches a method for soliciting or placing at least one order for footwear, comprising the steps of:

- providing at least one computer system operatively connected to a computer network (abstract);
- providing an order form through at least one computer system to be accessed by at least one user from a remote site (Fig. 1 - elements 15 and 20; Fig. 4 - S15);
- providing a first computer (Fig. 1 - element 15) at a store location and a second computer (Fig. 1 - elements 20 and 25) at a warehouse in communication with the first computer (§ [0040]);
- providing a third computer (Fig. 1 - element 40, “shoelast manufacturing unit”) at a manufacturing facility in communication with the first and second computers;
- measuring the size of the user's foot to provide a size parameter using a device (Fig. 1 - element 10, “shape measuring tool”) connected to at least one computer system (Fig. 2-3; § [0006]; § [0041]-[0052]);
- providing a first parameter of personalization (§ [0012]);
- providing a second parameter of personalization (§ [0012]);
- providing a third parameter of personalization (§ [0012]);
- providing a fourth parameter of personalization (§ [0074]);
- entering the first, second, third, and fourth parameters on the order form (§ [0012], § [0074]);
- submitting the order form through at least one computer system, wherein at least one computer system translates the size, first and second parameters on the order form into manufacturing control data, and wherein the manufacturing control data is used to manufacture the golf shoes according to each parameter

in the order form (§ [0012]); As per claim 46, Lee and Rhodes clearly teach the method of claim 14 as described above. Lee does further teach wherein prior to the step of receiving the golf shoes, the method further comprises the steps of translating the size, first, and second parameters into manufacturing control data and using the manufacturing control data to create the golf shoes (i.e. § [0012]).

- receiving the foot wear according to each parameter in the order form (§ [0054], lines 18-19).

10. Lee does not teach that one of the parameters is a cleat type and providing another of the parameters consists of traction level and cushioning.

11. As per claim 16, Lee/Rhodes/Hersey/Baker clearly teach the method according to claim 14 as described above. Lee does further teach wherein two computers are in communication, and wherein the order is passed from one computer to the other (Fig. 1 – elements 15 and 20; § [0040]; The Examiner is interpreting the “warehouse” to be a building where goods are stored. Therefore, the “manufacturing facility” where the custom shoes are produced, it is inherent that the manufacturing facility must store some goods if it is to produce such shoes quickly and efficiently.).

12. As per claim 17, Lee/Rhodes/Hersey/Baker clearly teach the method according to claim 14 as described above. Lee further teaches wherein the step of providing at least one computer further includes providing a third computer (Fig. 1 – element 40; § [0040]) at a manufacturing facility in communication with the first and second computers.

13. However, Rhodes does teach a “Golf Shoe” that allows for such accessories as cleat type (col. 20, lines 27-30), various traction levels (col. 20, lines 27-30; or, col. 20, lines 57-65; There are various options to further enhance the traction of a player’s golf shoe, as noted in Rhodes, anything from the cleat type to the construction of tongue or the shoe, to the way the sole is made can be associated with various traction levels) and cushioning (col. 20, lines 31-35 ;col. 20, lines 52-56; The Examiner is interpreting “cushioning” to be associated with the construction of the shoe, and the specific materials the insole is constructed from), among other things.

14. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the options associated with the “Golf Shoe” of Rhodes with the customization of the footwear of Lee for the useful purpose of allowing the user to personalize his/her golf shoe. As one of ordinary skill in the art knows, everyone has different feet and prefers various things while walking on them. The teachings of Rhodes and Lee clearly teach, in combination, that all of these features are old and well known in the art. Since everyone’s feet are different in some way, one of ordinary skill in the art would have been motivated to combine these two references to provide the customer with the maximum amount of options while selecting a custom golf shoe, and therefore maximize customer satisfaction of the buying and using experience.

15. Although Lee further teaches taking in the selected preferences of the customer, and inputting them into the manufactured shoe (§ [0012]), Lee and Rhodes do not explicitly teach the selection of a parameter that is an insole and outsole material of the shoe.

16. Hersey does teach the selecting of the insole (Anatomy of Hersey – “Vamp” – “This is the cloth part of the shoe, and we can make it with either nylon mesh or 200 denier nylon. The mesh is more breathable but a little heavier, so we usually use the 200 where the weight of the shoe is a concern.”) and outsole (Anatomy of Hersey – “Outersole – “The thinner piece of black rubber on the very bottom of the shoe is the *outersole*. It will vary in nature depending upon what the shoe is going to be used for. A racing flat, for example, will have a blown rubber Vibram® outersole that is light in weight and designed for good traction on even surfaces but not on icy roads or trails. Our standard carbon rubber outersole is a medium-weight, all-purpose sole ideal for trainers and walking shoes, and it can handle moderately uneven terrain. For hiking and running on unpredictable off-road and winter surfaces, our heavier deep-lug sole is probably in order.”).

17. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the reference of Hersey with Lee and Rhodes for the useful purpose of allowing the user to customize their shoes for specific events. For example, as taught by Hersey, a standard shoe, a racing-flat, and hiking and running shoes will have different outsoles from which the user can choose at his/her convenience.

18. Although Lee teaches taking in the selected custom preferences of the customer, and inputting them into the manufactured shoe (§ [0012]). The combination Lee does not however teach a parameter that is a material treatment from the group consisting of a temperature responsive treatment, stain-proofing, and water-proofing.

19. Baker et al. does teach the step of selecting a material treatment for a new shoe (col. 5, lines 31-40; col. 5, lines 61-67) from the group consisting of a temperature responsive treatment (col. 6, lines 66 – col. 7, line 14), stain-proofing (col. 5, lines 23-30), and water-proofing (col. 5, lines 23-30).

20. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the reference of Baker et al. with Lee/Rhodes/Hersey for the useful purpose of allowing the customer to pre-treat his/her shoes prior to handling them themselves. As taught by Baker et al., there has long been a problem since the advent of shoes of traditional attempts at cleaning soiled and/or stained shoes. This material treatment will help to minimize the amount of times the user will have to do this to their shoes, and therefore would be advantageous to offer to the customer buying the customized shoes.

21. As per claim 15, Lee/Rhodes/Hersey/Baker clearly teach the method according to claim 14 as described above. Lee further teaches wherein the step of measuring the size includes providing one of the following measuring devices: laser-sizing device (Fig. 6; ¶ [0041]), photographic-sizing device, graduated-sizing device.

22. As per claim 44, Lee/Rhodes/Hersey/Baker clearly teach the method of claim 14 as described above. Lee further teaches taking in the selected custom preferences of the customer, and inputting them into the manufactured shoe (¶ [0012]). Lee does not

however teach the step of selecting a material treatment from the group consisting of a temperature responsive treatment, stain-proofing, and water-proofing.

23. Baker et al. does teach the step of selecting a material treatment for a new shoe (col. 5, lines 31-40; col. 5, lines 61-67) from the group consisting of a temperature responsive treatment (col. 6, lines 66 – col. 7, line 14), stain-proofing (col. 5, lines 23-30), and water-proofing (col. 5, lines 23-30).

24. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the reference of Baker et al. with Lee/Rhodes/Hersey/Baker for the useful purpose of allowing the customer to pre-treat his/her shoes prior to handling them themselves. As taught by Baker et al., there has long been a problem since the advent of shoes of traditional attempts at cleaning soiled and/or stained shoes. This material treatment will help to minimize the amount of times the user will have to do this to their shoes, and therefore would be advantageous to offer to the customer buying the customized shoes.

25. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee/Rhodes/Hersey/Baker and further in view of Allen (Reference U on the attached PTO-892).

26. Lee/Rhodes/Hersey/Baker clearly teach the method of claim 14 as described above. Lee further teaches taking in the selected preferences of the customer, and inputting them into the manufactured shoe (§ [0012]). Lee does not however teach the

steps of: providing a custom indicia while choosing the custom indicia application method from the group consisting of punching, embroidering, printing, and inscribing; and inputting the custom indicia application method on the order form.

27. Allen does teach the steps of providing custom indicia (col. 5, lines 37-53) with means to embroider (abstract), print (abstract), punch (col. 5, lines 37-53) or inscribe (Fig. 5 - 6) the indicia onto a textile.

28. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the reference of Allen with Lee and Rhodes for the useful purpose of allowing the user to customize a program and turn the program into a result which can be translated via embroidery, printing, punching and inscribing, as taught by Allen.

29. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee/Rhodes/Hersey/Baker in view of Cisneros (U.S. Patent No. 6,092,605).

30. Lee/Rhodes/Hersey/Baker clearly teach the method of claim 14 as described above. Lee further teaches taking in the selected custom preferences of the customer, and inputting them into the manufactured shoe (§ [0012]). Lee/Rhodes/Hersey/Baker does not further teach wherein the step of providing a second parameter comprises selecting a traction level from the group consisting of ridges, grooves, and projections.

31. Cisneros does teach a "horseshoe traction device and system" which teaches a traction device consisting of ridges (col. 2, lines 44-57), grooves (col. 2, lines 44-57), and projections (abstract).

32. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the horseshoe traction device of Cisneros with that of an actual golf shoe corresponding to the combination of Lee/Rhodes/Hersey/Baker for the useful purpose of providing the user with traction while playing a sport, or simply while walking around. It is advantageous from a business perspective to offer these options to users because you can accommodate more people with more options, because everyone has their own preferences and will be willing to buy the product if their preferences are being offered.

33. Claims 27-31, 33, 41, 42 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (U.S. Publication No. 2001/0020222 A1) in view of Rhodes (U.S. Patent No. 5,887,363) in view of Hersey (Reference U on the PTO-892 form mailed June 22, 2007) in view of Baker et al. (U.S. Patent No. 6,861,396) and further in view of Rudy (U.S. Patent No. 6,127,010).

34. As per claim 27, Lee/Rhodes/Hersey/Baker teaches the method of claim 14 as described above. Lee further teaches taking in the selected preferences of the customer, and inputting them into the manufactured shoe (¶ [0012]). However, Lee

does not explicitly further teach wherein the customer can select at least one cushioning parameter selected from the group consisting of amount, type, hardness, and location.

35. Rudy does teach wherein the customer can select at least one cushioning parameter selected from the group consisting of amount, type (col. 6 lines 41-49), hardness (inherently, by selecting the type as above), and location (col. 6 lines 62-68).

36. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the reference of Rudy with Lee and Rhodes for the useful purpose of giving the customer the opportunity to maximize his customization of his shoe. While each cushioning has its own advantage, its cushioning could be chosen for various kinds of golfing days, shoe type and personal preference, as taught by Rudy.

37. As per claim 30, Lee/Rhodes/Hersey/Baker/Rudy clearly teach the method of claim 27 as described above. Lee further teaches wherein the step of providing at least one measuring device further comprises providing at least one of a laser-sizing device (Fig. 6; ¶ [0041]), a photographic-sizing device, or a graduated-sizing device.

38. As per claim 31, Lee/Rhodes/Hersey/Baker/Rudy clearly teach the method of claim 27 as described above. Lee further teaches the step of providing the footwear according to the order form by manufacturing the footwear at a manufacturing facility at a location different from the remote site (Fig. 1 – element 20 and 40; ¶ [0040]).

39. As per claim 41, Lee/Rhodes/Hersey/Baker/Rudy clearly teach the method of claim 27 as described above. Lee does not further teach wherein the cleat type comprises metal or plastic.

40. However, Rhodes does teach customizing the shoe with respect to the cleat type (col. 20, lines 27-30).

41. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the references of Rhodes with Lee for the useful purpose of giving the customer the option to select use of various kinds of spikes. As one of ordinary skill in the art would know, this would be advantageous because at some golf courses a golfer cannot use metal spikes, and therefore would use an alternative, plastic, etc. Not only do some courses not allow various kinds of cleats, but also one might use different cleats in different weather. For example, in rain the golfer might use metal spikes (if allowed) due to an increase in traction on the wet grass, but in dry weather use the “soft spikes” or plastic because it is more comfortable and the golfer does not need the extra traction on the dry ground.

42. As per claim 47, Lee/Rhodes/Hersey/Baker/Rudy clearly teach the method of claim 27 as described above. Lee further teaches wherein prior to the step of receiving the golf shoes, the method further comprises the steps of translating each parameter into manufacturing control data and using the manufacturing control data to create the golf shoes (i.e. ¶ [0012]).

43. As per claim 33, Lee/Rhodes/Hersey/Baker/Rudy clearly teach the method of claim 27 as described above. Lee further teaches taking in the selected preferences of the customer, and inputting them into the manufactured shoe (¶ [0012]). However, Lee does not further teach explicitly wherein the customer can select various forms of cushioning for the shoe.

44. Rudy does teach selecting a cushioning type for a shoe (Fig. 1 and 2), wherein the choices of cushioning comprise rubber plugs (col. 6, lines 27-40), air plugs (col. 5, lines 58-61), gel cushions (col. 8, lines 18-26), foam (col. 6, lines 41-49), or mixtures thereof.

45. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the reference of Rudy with Lee/Rhodes/Hersey/Baker/Rudy for the useful purpose of giving the customer the opportunity to maximize his customization of his shoe. While each cushioning has its own advantage, its cushioning could be chosen for various kinds of golfing days, shoe type and personal preference, as taught by Rudy.

46. As per claim 42, Lee/Rhodes/Hersey/Baker clearly teach the method of claim 14 as described above. Lee further teaches taking in the selected preferences of the customer, and inputting them into the manufactured shoe (¶ [0012]). However, Lee does not further teach explicitly wherein the customer can select various forms of cushioning for the shoe.

47. Rudy does teach selecting a cushioning type for a shoe (Fig. 1 and 2), wherein the choices of cushioning comprise rubber plugs (col. 6, lines 27-40), air plugs (col. 5, lines 58-61), gel cushions (col. 8, lines 18-26), foam (col. 6, lines 41-49), or mixtures thereof.

48. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the reference of Rudy with Lee/Rhodes/Hersey/Baker for the useful purpose of giving the customer the opportunity to maximize his

customization of his shoe. While each cushioning has its own advantage, its cushioning could be chosen for various kinds of golfing days, shoe type and personal preference, as taught by Rudy.

49. Claims 34, 35-38, 40, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee/Rhodes/Hersey/Baker/Rudy and further in view of Allen (U.S. Patent No. 5,144,899).

50. As per claims 34, 35-38, 40, and 48, Lee/Rhodes/Hersey/Baker/Rudy clearly teach the method of claim 27 as described above. Lee further teaches taking in the selected preferences of the customer, and inputting them into the manufactured shoe ([0012]). Lee does not however teach the step of: providing a custom indicia while choosing the custom indicia application method from the group consisting of punching, embroidering, printing, and inscribing; and inputting the custom indicia application method on the order form.

51. Allen does teach the method of providing custom indicia (col. 5, lines 37-53) with means to embroider (abstract), print (abstract), punch (col. 5, lines 37-53) or inscribe (Fig. 5 - 6) the indicia onto a textile.

52. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the reference of Allen with Lee/Rhodes/Hersey/Baker/Rudy for the useful purpose of allowing the user to

customize a program and turn the program into a result which can be translated via embroidery, printing, punching and inscribing, as taught by Allen.

53. Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee/Rhodes/Hersey/Baker/Rudy in view of Cisneros (U.S. Patent No. 6,092,605).

54. Lee/Rhodes/Hersey/Baker/Rudy clearly teach the method of claim 27 as described above. Lee further teaches taking in the selected custom preferences of the customer, and inputting them into the manufactured shoe (¶ [0012]).

Lee/Rhodes/Hersey/Baker/Rudy does not further teach wherein the step of providing a second parameter comprises selecting a traction level from the group consisting of ridges, grooves, and projections.

55. Cisneros does teach a “horseshoe traction device and system” which teaches a traction device consisting of ridges (col. 2, lines 44-57), grooves (col. 2, lines 44-57), and projections (abstract).

56. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the horseshoe traction device of Cisneros with that of an actual golf shoe corresponding to the combination of Lee/Rhodes/Hersey/Baker/Rudy for the useful purpose of providing the user with traction while playing a sport, or simply while walking around. It is advantageous from a business perspective to offer these options to users because you can accommodate

more people with more options, because everyone has their own preferences and will be willing to buy the product if their preferences are being offered.

57. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee/Rhodes/Hersey/Baker/Rudy/Allen in view of Cisneros (U.S. Patent No. 6,092,605).

58. Lee/Rhodes/Hersey/Baker/Rudy/Allen clearly teach the method of claim 35 as described above. Lee further teaches taking in the selected custom preferences of the customer, and inputting them into the manufactured shoe (¶ [0012]).

Lee/Rhodes/Hersey/Baker/Rudy/Allen does not further teach wherein the step of providing a second parameter comprises selecting a traction level from the group consisting of ridges, grooves, and projections.

59. Cisneros does teach a “horseshoe traction device and system” which teaches a traction device consisting of ridges (col. 2, lines 44-57), grooves (col. 2, lines 44-57), and projections (abstract).

60. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the horseshoe traction device of Cisneros with that of an actual golf shoe corresponding to the combination of Lee/Rhodes/Hersey/Baker/Rudy/Allen for the useful purpose of providing the user with traction while playing a sport, or simply while walking around. It is advantageous from a business perspective to offer these options to users because you can accommodate

more people with more options, because everyone has their own preferences and will be willing to buy the product if their preferences are being offered.

Examiner Note

61. The Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the Applicant, in preparing responses, to fully consider the reference in its entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claim Interpretation

62. Absent sufficient evidence in the specification that Applicant is acting as his own lexicographer, the Examiner is giving the term "golf shoe" its broadest reasonable interpretation as any shoe commonly worn when playing golf. This is not limited to shoes marketed as golf shoes but includes tennis shoes and other casual footwear.

63. The Examiner is interpreting the claimed "warehouse" to be a building where goods are stored. Therefore, the "manufacturing facility" where the custom shoes are produced is inherently also a warehouse, as it must store some goods if it is to produce

such shoes quickly and efficiently and must - at least temporarily - store shoes after manufacture.

64. Independent claims are examined together, since they are not patentably distinct. If applicant expressly states on the record that two or more independent and distinct inventions are claimed in this application, the Examiner may require the applicant to elect an invention to which the claims will be restricted.

Response to Arguments

65. Applicant's argument with respect to the objection to claim 14 has been fully considered and is persuasive. The objection to claim 14 has been withdrawn.

66. Applicant's arguments with respect to the 112 2nd ¶ rejections of the claims have been fully considered, but they are not fully persuasive. See the revised 112 2nd ¶ rejection above.

67. Applicant's arguments with respect to the 103 rejections of the claims have been fully considered but they are not persuasive.

68. In response to Applicant's argument that the references fail to show certain features of Applicant's invention (Applicant's "threshold matter"), it is noted that the features upon which Applicant relies (i.e., "the present invention allows for an order to be placed and a warehouse inventory to be checked to see if the particular order is in stock, thereby eliminating the need for the manufacturing facility to produce another") are not recited in the rejected claims. Although the claims are interpreted in light of the

specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

69. Regarding Applicant's argument that Lee does not disclose providing a first, second, and third computers, see the above rejection for an explicit mapping of the first, second, and third computers. Applicant also appears to be arguing that the warehouse and the manufacturing facility are not collocated; however, this is nowhere recited in the claims. Additionally, the elements mapped to the warehouse computer include a "storage unit" (element 25), therefore, since it stores customer data, it would not be unreasonable to refer to its location as a data warehouse. Finally, as the claims are currently phrased, none of the first, second, and third computers is necessarily utilized in the method steps (they are only provided). It is the Examiner's position that providing computers at a store, warehouse, and manufacturing facility, by itself, does not distinguish Applicant's invention from the prior art.

Conclusion

70. References considered pertinent to Applicant's disclosure are listed on form PTO-892. All references listed on form PTO-892 are cited in their entirety.

71. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jamie Kucab whose telephone number is 571-270-3025. The Examiner can normally be reached on Monday-Friday 9:30am-6:00pm EST.

72. Suggestions or examples of claim language provided by the Examiner in this Office Action are just that—suggestions or examples—and do not constitute a formal

requirement mandated by the Examiner. Unless stated otherwise by an express indication that the claim is “allowed,” exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has not been addressed with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

73. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner’s supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

74. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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JK

/ANDREW J. FISCHER/

Supervisory Patent Examiner, Art Unit 3621